

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Mark Vincent SHOEN

Serial No.: 09/557,459

Filed: April 24, 2000

For: FENDER HAVING OFFSET LIGHT
HOUSING

Art Unit: 3611

Examiner: Daniel Yeagley

Mail Stop Appeal Brief-
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by Bobbie Jean Corbin
Bobbie-Jean Corbin

REPLY TO EXAMINER'S ANSWER

Dear Sir/Madam:

This is a Reply to the Examiner's Answer, mailed on September 7, 2004 in an appeal from the decision dated February 3, 2003 finally rejecting claims 1-3, 6, 7, 9, 17, 29-31 and 39 as being unpatentable under 35 U.S.C. § 103(a) over Whitton, U.S. Patent No. 1,440,516 ("Whitton") in view of Caponi, U.S. Patent No. 2,001,705 ("Caponi"); finally rejecting claims 1-3, 6, 9-13, 15-17, 19, 20, 23, 24 and 27-39 as being unpatentable under 35 U.S.C. § 103(a) over Poveromo, U.S. Patent No. 4,442,644

Reply to Examiner's Answer

Appl. No. 09/557,459
Atty. Docket No. 57111-5072
Customer No. 24574

("Poveromo '644") in view of Poveromo, U.S. Patent No. 4,395,749 ("Poveromo '749"); finally rejecting claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable under 35 U.S.C. § 103(a) over Whitton as modified by Caponi in view of Hardwick, U.S. Patent No. 4,027,808 ("Hardwick"); and finally rejecting claims 34-38 under 35 U.S.C. § 102(b) as being anticipated by Whitton.¹

I. Whitton Does Not Anticipate Claims 34-38 Under 35 U.S.C. § 102(b)

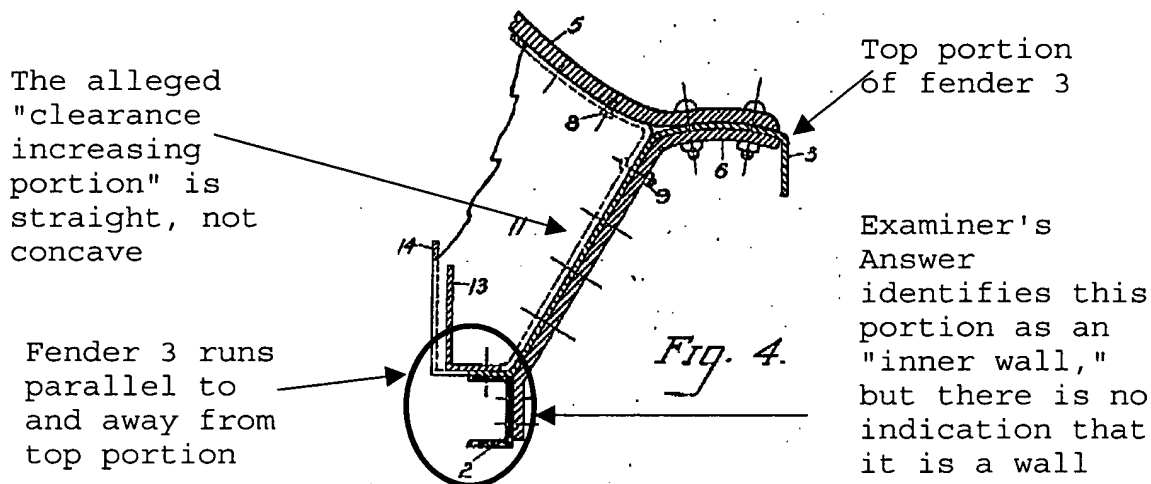
A. Whitton Does Not Anticipate Claims 36-38

Whitton does not anticipate claims 36-38. First, it fails to disclose an inner wall depending downwardly at a second non-zero acute angle from a clearance increasing portion in a second plane. The Examiner has attempted to characterize the combination of Whitton's components 3 and 6 as a fender. According to Whitton, however, component 3 is a fender and component 6 is a "support." Whitton at line 85. It is undisputed that the fender 3 does not have an inner wall depending downwardly from a clearance increasing portion as

¹ Where only a single claim or certain claims from any of the claim groupings listed in Applicant's Appeal Brief is mentioned, it should be understood that the patentable distinctions applicable to the specifically referenced claims apply equally to the remaining members of the group. In discussing only a certain claim or claims from any particular group, Applicant is not conceding that the Examiner's rejections are proper as to the remaining members of the group. In addition, where only an independent claim is discussed, the patentable distinctions applicable to those claims apply equally to their respective dependent claims.

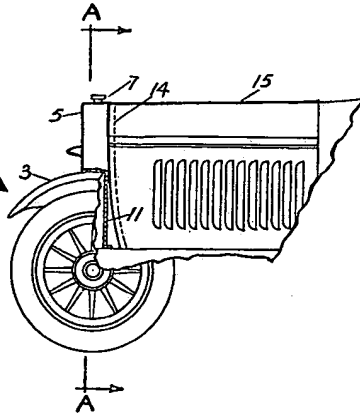
claimed. The portion of fender 3 located at the bottom of the alleged "clearance increasing portion" runs parallel to and away from the top portion of Whitton's fender, in direct contrast to inner wall recited in the claims. As a result, the Examiner relies on Whitton's support 6--not the fender 3--as including the claimed "inner wall."

Whitton's support 6 does not include the claimed inner wall. Whitton only shows the support from a front elevation view. Whitton gives no indication that the support extends any distance along the length of the vehicle or that it could otherwise reasonably be characterized as including an inner wall. If anything, support 6 appears to be a support bar located under the fender near the front of the vehicle.



Whitton's Figure 3 shows (at most) fender 3 and the alleged "clearance increasing portion." However, the figure does not show support 6, further indicating that support 6 is merely a bar and that it does not include an inner wall as claimed:

Whitton Fig. 3
Fender 3 does not include support 6 or otherwise show that support 6 includes an "inner wall" as claimed



Claims 36-38 further recite that the "top portion and said inner wall are oriented substantially perpendicularly." As shown above, Whitton's fender 3 does not include this feature. Because Whitton gives no indication that support 6 includes the claimed inner wall, Whitton fails to disclose the claimed perpendicular orientation between the top portion and inner wall of a fender as well. Thus, Whitton does not anticipate Claims 36-38.

B. Whitton Does Not Anticipate Claims 34 and 35

Claims 34 and 35 recite a concave clearance increasing portion. According to the Examiner, Whitton's Figures 1 and 3 show "the curved inner surface of the clearance increasing portion of the fender being obviously concaved in a direction from the front of the fender toward the rear of the fender . . .

" This is incorrect. The portion of Whitton's Figure 4 which the Examiner identifies as a clearance increasing portion is indisputably straight. While Figure 3 shows that the inner surface of the top portion of Whitton's fender could be described as having a "concave" profile (if viewed from inside the fender), there is no suggestion that the alleged "clearance increasing portion" is concave.

II. Claims 1-3, 6, 7, 9, 17, 29-31 and 39 Are Not Obvious Over Whitton in View of Caponi

A. Alone or in Combination, Caponi and Whitton Do Not Disclose Each of the Claimed Features

Caponi is directed to a safety turn stop light. According to the Examiner, Caponi discloses the use of light housings on the top curved surfaces of two rear fenders. However, Caponi does not compensate for Whitton's above-described deficiencies. Nor does Caponi suggest that there is any significance to the shape of the fender or provide any other suggestion or motivation which would lead one of ordinary skill in the art to combine it with Whitton.

1. Caponi and Whitton Do Not Disclose or Suggest the Fender Configuration of Claim 39

Claim 39 recites a clearance increasing portion depending downwardly from the top portion of a fender at a first

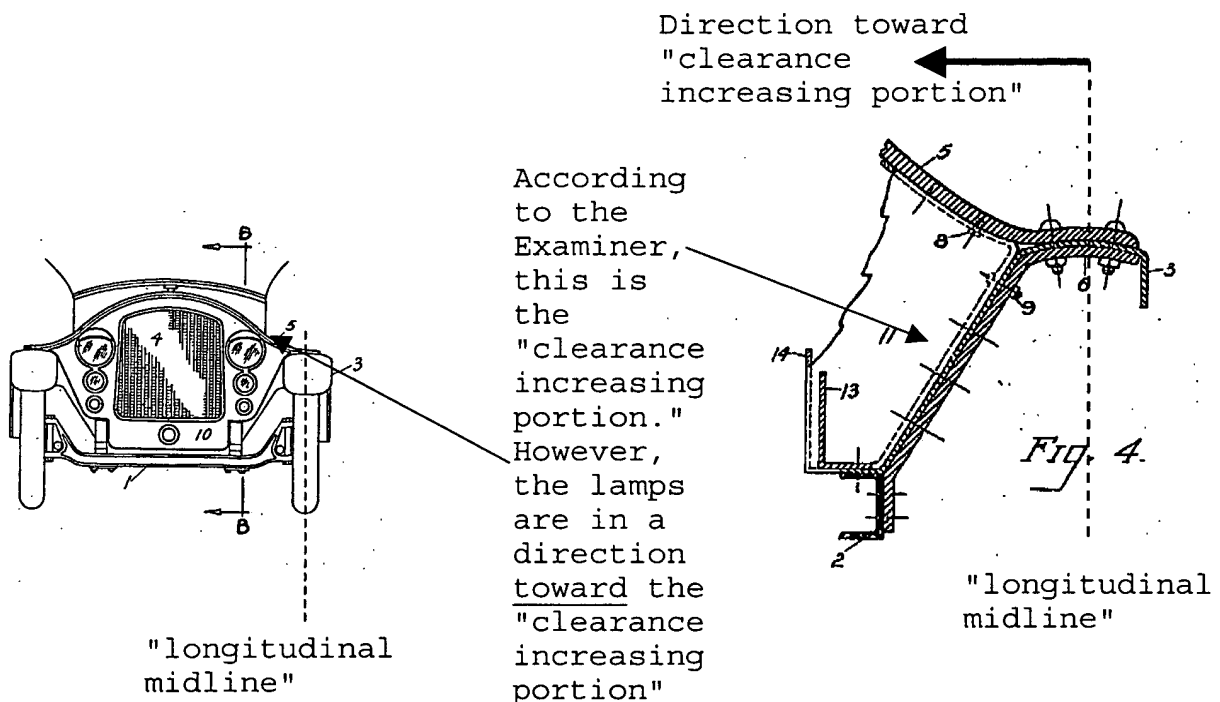
non-zero acute angle in a first plane, as well as an inner wall depending downwardly from the clearance increasing portion at a second non-zero angle in a second plane. The Examiner contends that Whitton discloses these features and concedes that Caponi does not. However, as explained above, the Examiner's application of Whitton is based on a mischaracterization of Whitton's "support 6." Whitton does not disclose the claimed fender configuration, and in particular, gives no indication that its support 6 includes the claimed "inner wall." Therefore, the combination of Whitton and Caponi does not disclose the claimed invention and cannot render it obvious.

2. Caponi and Whitton Do Not Disclose or Suggest the Fender Configuration or Light Housing Placement of Claim 1

Claim 1 recites the features of Claim 39 described above, and is allowable over Caponi and Whitton on that basis alone. However, Claim 1 is additionally distinguishable over the combined references based on the claimed location of the light housing.

Claim 1 recites a light housing offset from the midline of a fender in a direction away from the claimed clearance increasing portion. Neither Caponi nor Whitton disclose this feature. The Examiner contends that Whitton discloses "a light housing . . . offset from a longitudinal midline of the fender as broadly claimed" Examiner's Answer at 5. However, the

claim recites that the offset must be in a direction away from the claimed clearance increasing portion. As the claim clearly states, the reference point for evaluating the offset is the fender's longitudinal mid-line. When viewed from the longitudinal mid-line of Whitton's fender, Whitton's light housing is in a direction towards the clearance increasing portion, not away from it:



3. Whitton and Caponi Do Not Disclose Or Suggest the Fender Configuration of Claim 17

Claim 17 recites a concave clearance increasing portion. As mentioned above, Whitton does not disclose this feature, but at most, discloses a fender with a top inner surface that is concave. Caponi does not compensate for Whitton's

deficiencies in this regard. Thus, the combined references do not disclose or suggest the claimed invention.

B. The Examiner Has Failed To Establish a Prior Art Motivation or Suggestion for Combining Caponi and Whitton

The Examiner concedes that Caponi and Whitton can only be combined if "there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art." Examiner's Answer at 9. However, the only evidence cited by the Examiner in support of such a suggestion is unspecified "motivational reasons for incorporating a light to the fender for safety and functional purposes," which are allegedly found in Figure 1 and columns 1-2 of Caponi.

The rejected claims are directed to a fender having a particular geometry and combinations of such fenders with a light housing. The foregoing portions of Caponi disclose a fender having a light on it. However, Caponi is concerned with the design of stop lights. It ascribes no importance to locating such lights on the fender as opposed to locating them elsewhere on the rear of the vehicle. Nor does it ascribe any significance to the shape of the fender. Caponi provides no motivation for using the fender structure of Whitton. In contrast to the rejected claims, Whitton teaches the placement of light housings away from the top surface of the fender and in a direction toward

the alleged "clearance increasing portion." Thus, Caponi and Whitton could not merely be combined to obtain the claimed invention. They would have to be modified in a manner that is not suggested by either reference or any other prior art teaching. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 117 (Fed. cir. 1989) (emphasis added) (citations omitted).

Moreover, Whitton states that a "prime object of the invention is the provision of a substantial boxing for housing as a collective unit, the radiator, the lamps, the horn and any other adjuncts common to the front of an automobile, and by so doing present a continuous front or facing from fender to fender." Whitton at 1:16-22 (emphasis added). If Whitton's lamps were moved to the top surface of the fender, the lamps would not be housed as a single unit with the radiator, horn, etc., and the "prime object" of the reference would not be achieved. As a result, Whitton "would be rendered inoperable for its intended purpose." In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984) (reversing BPAI holding of obviousness). Further, Whitton teaches away from the claimed invention because "a person of ordinary skill, upon reading the reference . . . would be led in a direction divergent from the path that was taken by the applicant" Tec Air, Inc. v. Denso Mfg. Michigan, Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999). Given the foregoing, the

Examiner has not established a prior art motivation or suggestion to combine Whitton and Caponi. See Id. at 1360 ("There is no suggestion to combine, however, if a reference teaches away from its combination with another source").

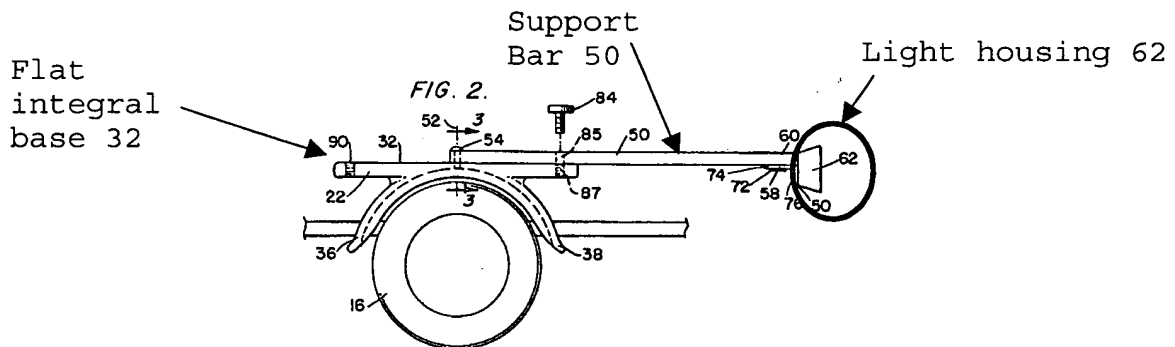
III. Claims 1-3, 6, 9-13, 15-17, 19, 20, 23, 24 and 27-39
Are Not Obvious Over Poveromo '664 In View of Poveromo
'749

The Examiner asserts that Poveromo '664 discloses a fender having the claimed clearance increasing portion and inner wall. However, because the Poveromo '664 fender has an integral flat base, the Examiner has combined it with Poveromo '749, which he asserts shows "the art of attaching a light housing . . . more closely resembling the fender and light housing as broadly claimed." Examiner's Answer at 10-11. However, neither reference shows the features of the rejected claims. In addition, Poveromo '664 teaches away from the claimed invention and from the structure disclosed in Poveromo '749. Therefore, there is no suggestion to combine the references, and their combination to reject the claims is improper.

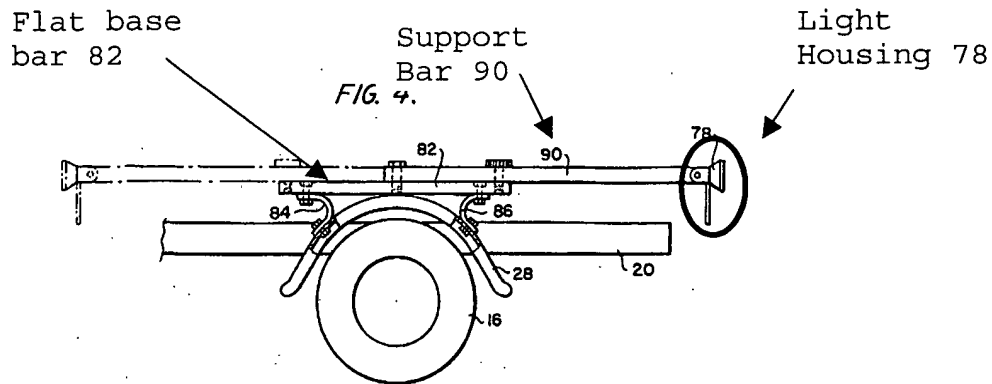
A. Poveromo '664 and Poveromo '749 Do Not Disclose
Each of the Claimed Features

1. The Poveromo References Do Not Disclose The
Attachment of a Light Housing to the Curved
Surface of the Top Portion of a Fender as
Recited in Claim 1

Claim 1 recites a light housing that is attached to the curved surface of the top portion of a fender. Neither Poveromo reference discloses this feature. The Examiner contends that Poveromo '664 is "broadly readable" as showing a light housing attached to the curved surface of a fender. That is not correct. The light housing 62 of Poveromo '664 is attached to a support bar 50 which is in turn attached to the flat integral surface of a fender. Neither the light housing 62 nor the support bar 50 are attached to a curved surface:



Poveromo '749 is similarly unavailing. Its light housing 78 is attached to support bar 90, which is in turn attached to a flat base bar 82:



Thus, the combined references fail to disclose the attachment of a light housing to the curved top surface of a fender, as recited in Claim 1. As a result, they cannot render it obvious.

2. Neither Poveromo Reference Discloses the Tow Dollies of Claim 20 and 21

Claims 20 and 21 recite the use of Applicant's inventive fender in a tow dolly. The Examiner asserts that "Poveromo '664 shows various fender and light housing arrangements on a . . . tow dolly for towing a boat." Examiner's Answer at 10. However, this assertion is incorrect. The Poveromo references disclose boat trailers, but do not address tow dollies.

As explained in Applicant's specification, "tow dollies support only one axle [of a vehicle], leaving the tires of the second axle in contact with the road surface whereby the tow dolly does not carry the portion of vehicle weight apportioned to that axle." Application at 1:23-25. "These tow dollies include a platform mounted on an axle on which the front (or rear) wheels

of a vehicle to be towed are mounted. A pair of loading ramps extend from the platform for driving the front (or rear) wheels onto the platform." Id. at 1:26-2:1. Neither Poveromo reference discloses or suggests the use of such an apparatus or mentions a tow dolly. As a result, the combined references cannot render Claims 20 and 24 obvious.

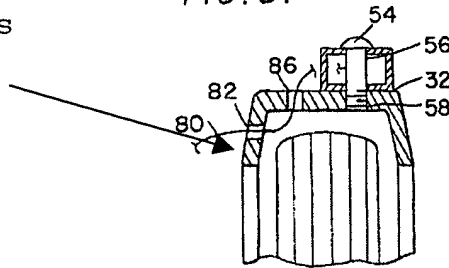
3. Neither Poveromo Reference Discloses the
Concave Clearance Increasing Portion of
Claims 17, 34 and 35

Claims 17, 34 and 35 recite the use of a fender comprising a concave clearance increasing portion.² According to the Examiner, in Poveromo '664 "the clearance increasing portion is clearly shown as having an inner concaved surface (side walls of the fender as seen in figure 4 and 8)." The referenced figures show, at most, that the combination of the top surface of the fender and the alleged "clearance increasing portion" gives the appearance of concavity when viewed from inside the fender. However, the alleged "clearance increasing portion" itself is straight, not concave, as indicated in Poveromo '664 Figure 3:

² As mentioned in the Applicant's Appeal Brief, with respect to the Poveromo references, Applicant argued Claims 17, 32-33 and 34-35 together because their common features are distinguishable from the combined Poveromo references. However, they are grouped separately because they have patentably distinct features that led the Examiner to reject Claims 34 and 35, but not Claim 17, based on Whitton alone and to reject Claims 32-33, but not Claim 17 or Claims 34-35, based on the combination of Caponi, Whitton and Hardwick.

The Examiner apparently contends that this section is a "clearance increasing" portion. However, it is straight, not concave.

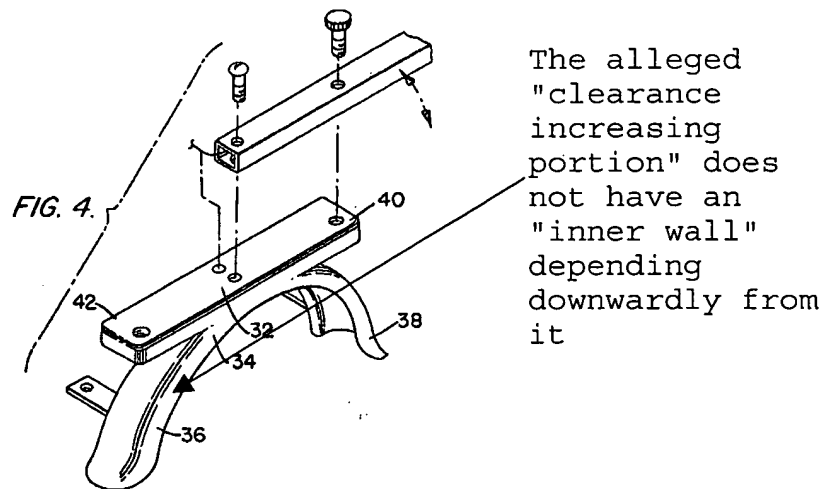
FIG. 3.



4. Neither Poveromo Reference Discloses the Co-Planar Arrangement of the Bottom Edges of an Inner Wall, Clearance Increasing Portion, Top Portion, and Outer Wall as Recited In Claim 28

Claim 28 recites a fender with a clearance increasing portion, inner wall, outer wall and top portion, each having bottom edges that lie in a common plane. As claimed, the inner wall depends downwardly from the clearance increasing portion at a non-zero angle, and the clearance increasing portion depends downwardly from the inner edge of the top portion.

According to the Examiner, these features are disclosed in Figures 4 and 8 of Poveromo '664. However, those figures do not disclose the claimed inner wall depending downwardly from a clearance increasing portion. Thus, they do not disclose the claimed relationship between the bottom edges of an inner wall, clearance increasing portion, outer wall, and top portion. At most, Figures 4 and 8 show a top portion, an outer wall and a clearance increasing portion:



Thus, neither the figures nor the text of either Poveromo reference discloses the features of Claim 28. Thus, the combined references do not render it obvious.

B. The Examiner Has Failed to Establish a Motivation or Suggestion in the Prior Art for Combining the Poveromo References to Obtain the Claimed Invention

According to the Examiner, "it would have been obvious to one of ordinary skill in the art to have utilized a separate and more simpler light housing base as suggested by Poveromo '749 which conforms to the curved portion of the fender for mounting a light housing to the fender of a trailer which would reduce manufacturing cost." Examiner's Answer at 11. The Examiner apparently contends that one of ordinary skill in the art would have been motivated to eliminate the integral base 32 of Poveromo

'664 in favor of the separate base 82 of Poveromo '749.

First, Poveromo '664 belies the Examiner's contention. It specifically states the importance of the unitary base/fender as compared to the prior art:

Unlike the present invention, the prior art does not disclose a unitary fender structure having a base to support a hollow bar having the trailer lamp and license plate attached at one end thereof This construction provides a single piece fender to fit over the wheels of a trailer"

Poveromo '664 at 1:22-29 (emphasis added).

Poveromo '664 further states that "[o]ne object of this invention is to construct a unitary fender for boat trailers to support a bar to which are attached the trailer lamps" and that "[o]ne other object . . . is to construct a fender having a horizontal base portion " Poveromo '664 at 1:59-63.

In addition, there is nothing "simpler" about the structure of the Poveromo '749 fender which would motivate one of ordinary skill in the art to substitute it for the integral base of Poveromo '664. The Poveromo '749 fender includes a separate base 82 as well as separate brackets 84 and 86 and nuts and bolts 88 to connect the brackets to the fender and to the base 82. Poveromo '749, Figure 4. The assertion that such a structure is "simpler" or less expensive than the integral base of Poveromo '664 is unsupported conjecture, which is insufficient to support an obviousness rejection. "The factual inquiry whether to combine references must be . . . based on objective evidence of

record." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (holding that "[t]his factual question of motivation [to combine references] could not be resolved on subjective belief and unknown authority"). The Examiner has cited no evidence establishing his purported motivation to combine the Poveromo references and eliminate the flat integral base of Poveromo '664. Thus, the rejection is improper.

Second, as mentioned above, neither Poveromo reference discloses attaching a light housing to the curved surface of the top portion of a fender, as recited in Claim 1. In fact, the references specifically teach away from it. The whole purpose of the Poveromo design is to "permit[] the lamp to be re-located from the rear of the trailer to the forward end of the trailer during launching of a boat so that the lamp and associated electrical wiring will not contact the water" Poveromo '664 at 1:29-32. To achieve this goal, each Poveromo reference attaches its light housing to a horizontal support bar. The only way such a support bar can be stably attached to a curved fender is by attaching the bar to a flat base, not to a curved fender surface. As a result, both Poveromo references require attaching the support bar to a flat base which is in turn integrally formed with or separately attached to the fender, as shown in Poveromo '644 Figure 2 and Poveromo '749 Figure 4.

Modifying the Poveromo references to attach the light housing to the curved surface of the fender as recited in Claim 1 would render the Poveromo trailers unable to perform their intended function of providing re-locatable lamps. As a result, the Poveromo references cannot properly be combined to reject Applicant's claims. See In Re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984) (reversing BPAI holding of obviousness where modifying reference to obtain claimed invention would have rendered the reference "inoperable for its intended purpose").

IV. Claims 32 and 33 Are Not Obvious Over Whitton As Modified by Caponi In View of Hardwick

A. The Combined References Do Not Disclose All of the Features of Claims 32 and 33

Claims 32 and 33 depend from Claim 17. Claim 32 recites that the top portion of the claimed fender has a substantially flat middle section, while Claim 33 recites that the top portion comprises a plurality of planar sections. The Examiner relies on Hardwick solely for its disclosure of fenders having one or more planar sections. However, Hardwick does not compensate for the deficiencies of Caponi and Whitton. The combined references do not disclose an inner wall depending downwardly from a clearance increasing portion of a fender. Nor

do they disclose a concave clearance increasing portion, as claimed. As a result, the combined references cannot render Claims 32 and 33 obvious.

B. The Examiner Has Failed to Identify a Suggestion
or Motivation In the Prior Art for Combining
Caponi, Whitton and Hardwick

The Examiner has not identified any prior art motivation or suggestion for combining Caponi and Whitton with Hardwick.³ As mentioned above, there is no such suggestion for combining Whitton and Caponi, let alone combining them both with Hardwick. Moreover, nothing in Hardwick suggests that there is any importance to the cross-sectional shape of the fender which would motivate one of ordinary skill in the art to modify it based on the Whitton fender. Conversely, one of ordinary skill in the art viewing Whitton would have no reason to include the planar fender sections of Hardwick given that Whitton deals with passenger cars and does not address multi-axle vehicles, such as those shown in Hardwick. See Hardwick at 2:67-3:4.

³ With respect to identifying a motivation or suggestion for combining the references, the Examiner's Answer contains a single, incomplete

CONCLUSION

Based on the foregoing, all pending claims are patentable over the references of record, and it is respectfully requested that the rejections of all pending claims be withdrawn and that the claims be allowed.

Respectfully submitted,

JEFFER, MANGELS, BUTLER & MARMARO LLP

Dated: _____

10/20/04

By: _____



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sentence which reads: "In this case, such when covering a dual axle wheeled vehicle as taught by Hardwick."